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EXAMINER
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MCCORMICK, GABRIELLE A

ART UNIT	PAPER NUMBER
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3629

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,207	<b>Applicant(s)</b> SCHLESINGER ET AL.	
	<b>Examiner</b> Gabrielle McCormick	<b>Art Unit</b> 3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9, 11-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the amendments filed on June 24, 2009.
2. Claims 1, 3-5, 9 and 11-12 have been amended.
3. Claims 2 and 10 have been canceled.
4. Claims 1, 3-9 and 11-12 are currently pending and have been examined.

### ***Previous Claim Objections***

5. The Examiner thanks the Applicant for the attention to the previous claim objections. As a result of Applicant's cancellation of claims 2 and 10, the objections are moot and are withdrawn.

### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:  
  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
7. Claims 1 and 3-5 are rejected as being directed to non-statutory subject matter. Claims 1 and 5 are method claims that recite process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).

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8. Claims 1 and 5 have been amended to recite a “computer-implemented method in the preambles, however, structural elements solely recited in the preamble are not accorded patentable weight. To overcome this rejection, the structural elements should be recited as part of the body of the claim.
9. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claims 1 and 5 fail that test and is therefore rejected under 35 USC 101. Claims 3-4 are rejected through dependency from claim 1.

### ***Claim Rejections - 35 USC § 112***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
11. Claims 1 and 3-5 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
12. Claims 1 and 5 recite a “computer-implemented method” in the preambles, however, the bodies of the claim do not incorporate any recitation of computer implementation. The claims are therefore indefinite because the bodies of the claims are inconsistent with the preambles.

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 1-6 and 8-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stirpe et al. (US Pub. No. 2002/0087496, hereinafter referred to as “Stirpe”) in view of Menon et al. (US Pub. No. 2002/0152318, hereinafter referred to as “Menon”).
15. **Claims 1 and 9:** Stirpe teaches the provision of a “knowledge component” (i.e. course masters) “and its characteristics” (i.e., metadata associated with the course master) (P[0076]). Characteristics include the title, unique identification, price, description, and titles of sub-components (i.e., sessions with differing dates/times). Additionally, each session has characteristics (i.e., metadata) (P[0077]). Sessions are understood to be analogous existing course offerings as they are associated with metadata that defines “start and end dates and times” (P[0082]). Updates to content and metadata can be performed either manually or automatically. (P[0083]). Specifically, Stirpe discloses:
- *a method for selectively applying course content updates in a learning management system, the method comprising the step of processing an update to course metadata* (P[0083]: the “characteristics” are understood to be examples of metadata).
  - *identifying within a course package a course metadata update to an associated course master;* (P[0083]: the knowledge component and characteristics comprise the “course package”. “The expert may manually enter or update the knowledge component and or characteristics, such as offering dates and times...at any time to keep the information up-to-date.” Thus, the characteristics (i.e., metadata) are updated.)
  - *determining whether to wholly reject said course metadata update to said associated course master, or to apply said course metadata update to said associated course master;* (P[0085]: “If there are errors in the document, the knowledge exchange system may not apply all or part of the documents to the data store”. The “document” is an update as it is transmitted “whenever new or corrective adjustments need to be made to the institutions knowledge components”).

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- *further determining whether to apply said course metadata update to existing course offerings based upon said associated course master, or whether to exempt said existing course offerings from said course metadata update* (P[0086]: the content management system helps the author determine how/when/to whom updates should be applied, thus determining whether to exempt existing course offerings from the update.)
16. Stirpe does not explicitly disclose that the updating to the metadata is processed separately from the content.
17. Menon, however, discloses loading or updating metadata separately from the content it is associated with. (P[0064]).
18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]) Further, Stirpe would see the benefit of lower costs of the separation of processing metadata updates from content updates as metadata updates can be performed as a scheduled “push” that is designed to minimize cost and/or disruption to other network activity. (Menon; P[0071]). In P[0033-0037], Stirpe discloses fee collections for the system, therefore, Stirpe discloses a profit motive. It is obvious that minimizing costs aid in generating a larger net income. Thus, Stirpe would be motivated to employ the separation of metadata and content updates, as taught by Menon, in order to achieve increased profitability.
19. **Claims 3 and 11:** Stirpe discloses
- *extracting a package identifier for said course package;* (P[0083]: knowledge component has a unique identifier and P[0126-0127]: each knowledge component and session has a unique number).
  - *comparing said identifier with other identifiers associated with existing course masters disposed within the learning management system; and,* (P[0086]: updates are selectively applied, thus the comparison of identifiers is inherent in the selective updating process.)

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- *performing said identifying, determining and further determining steps only where said comparison indicates that said course package incorporates said update.* (P[0085]: institutions transmit documents whenever new or corrective adjustments need to be made, therefore, only updates are transmitted and therefore the processes of identifying, determining and further determining are performed only when a course package includes an update.)
20. Further, updating may be performed manually by the expert who can update the knowledge component and or the characteristics (i.e., metadata). (P[0083]. As each course has a name and or unique identifier, when updating by the expert, in order to perform the updating, a comparison must be made to discern which course requires updating in order “to keep the information up-to-date”. (P[0083]). By disclosing that the information is kept up-to-date through allowing updates at any time, the identifying, determining and further determining are performed when an update exists.
21. **Claims 4 and 12:** Stirpe discloses updating knowledge components and characteristics (i.e., course masters) in a selective manner such that not all updates are applied (P[0086]), but does not explicitly disclose a *listing*.
22. Menon, however, discloses a “scheduled push” of metadata. (P[0071]). It is inherent is scheduling a push of metadata that a listing would be employed.
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a listing, as disclosed by Menon, in the system of Stirpe for the motivation of minimizing the cost and/or disruption to other network activity. (Menon; P[0071]).
24. **Claim 5:** Stirpe discloses
- *authoring a course metadata update to an existing course deployed within the learning management system;* (P[0079]: the characteristics are altered (i.e., an update is authored); P[0083]: the expert updates the characteristics and P[0085]: trainers author knowledge components).

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- *packaging said course metadata update in a course package and importing said course package into the learning management system;* (P[0086])
  - *selecting whether to apply said course metadata update to all course offerings for said existing course, or only to new course offerings for said existing course.* ((P[0085]: “If there are errors in the document, the knowledge exchange system may not apply all or part of the documents to the data store”. The “document” is an update as it is transmitted “whenever new or corrective adjustments need to be made to the institutions knowledge components” and P[0086]: the content management system helps the author determine how/when/to whom updates should be applied, thus determining whether to exempt existing course offerings from the update.)
25. Stirpe does not disclose that the updating to the metadata is processed separately from the content.
26. Menon, however, discloses loading or updating metadata separately from the content it is associated with. (P[0064]).
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]).
28. **Claim 6:** Stirpe discloses
- *a learning management server coupled to a delivery server;* (Fig. 1 and P[0091]; knowledge exchange service comprises the server)
  - *a database coupled to said learning management server and configured to store course masters arranged to describe course offerings for deployment in said delivery server;* (Fig. 1 and P[0080]).
  - *update logic disposed within said learning management server, said update logic comprising programming for selectively updating course offerings disposed in said delivery server with one of updated course metadata alone, updated course content alone, and both updated*



*course metadata and course content, based upon a course update package uploaded into said learning management server.* (P[0086]).

29. Stirpe does not disclose that the updating to the metadata is processed separately from the content.
30. Menon, however, discloses loading or updating metadata separately from the content it is associated with. (P[0064]).
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included separately updating metadata from content, as disclosed by Menon in the system disclosed by Stirpe, for the motivation of providing a method of lowering the costs associated with distributing content using bandwidth. (Menon; P[0024] and [0034]).
32. **Claim 8:** Stirpe discloses that the knowledge exchange service is utilized for delivery of the knowledge components. (P[0092]). Further, Stirpe discloses that users can search for specific course offerings, thus the delivery is response to a user request. (P[0091]).
33. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over Stirpe et al. (US Pub. No. 2002/0087496, hereinafter referred to as "Stirpe") in view of Menon et al. (US Pub. No. 2002/0152318, hereinafter referred to as "Menon") in further view of Theilmann et al. (US Pub. No. 2003/0175676, hereinafter referred to as "Theilmann").
34. **Claim 7:** Stirpe discloses that update packages are authored (P[0079]: the characteristics are altered (i.e., an update is authored); P[0083]: the expert updates the characteristics and P[0085]: trainers author knowledge components), but does not disclose an *authoring tool*.
35. Theilmann, however, discloses an authoring tool (P[0079-0086] and Fig. 7).
36. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included an authoring tool, as disclosed by Theilmann, in the system of Stirpe for the motivation of providing the means for the experts, trainers and contributors from the institutions to create the content. It is clear that Stirpe discloses that content and metadata are authored, therefore it is obvious to expand Stirpe to include the means by which this takes place.

### ***Response to Arguments***

37. Applicant's arguments filed June 24, 2009 have been fully considered but they are not persuasive. The Examiner has provided detailed analysis (above) of how the prior art of record reads on the claim language.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./  
Examiner, Art Unit 3629

/JOHN G. WEISS/  
Supervisory Patent Examiner, Art Unit 3629